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EXAMINER

SHARP, JEFFREY ANDREW

ART UNIT PAPER NUMBER

3677

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,591

Applicant(s)

BEHLE ET AL.

Examiner

Jeffrey Sharp

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to Applicant's remarks/amendment filed on 7 March 2005 with regard to the Official Office action mailed on 6 December 2004.

Status of Claims

[1] Claims 1-11 are pending.

Claim Objections

[2] Claim(s) 1, 6, and 8 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 7 March 2005. Accordingly, the objection(s) to the claim(s) have been withdrawn.

As amended, claim 8 is objected to, because the added word "and" is misplaced, and should come after "component (1)".

New Grounds of Rejection

Claim Rejections - 35 USC § 112

[3] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[4] Claim 1 and dependent claims 2-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is not clear how the flange (3) of claim 1 can be completely surrounded by a separate sealing washer, when a compressible spacer (5) is connected to a portion of the flange (see Figures and claim 9). Further, it is not clear how the flange can "bear on one side of the component," if a sealing washer portion is "integrally provided on a side of the flange facing the component". Further, there is a lack of structural definition for the broad limitations "shoulder" and "collar", because now the sealing washer completely surrounds the flange. Applicant is required to clarify that the "shoulder" and "collar" are portions of the sealing washer that axially project beyond a thickness of the sealing washer if they are to be given their same meaning disclosed in the drawings (particularly Figure 5) and specification. It is not clear if Applicant intends "collar" to be an axially projecting extension (19) found in the pursued embodiment in Figure 5.

See Kurihara US-4,840,522 which shows a separate integrally provided sealing washer (18) "completely surrounds" an inner flange portion., and has a collar that projects inside of an aperture.

Claim Rejections - 35 USC § 103

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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[6] As it is understood, claims 1, 5, 7, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaeger et al. US-5,636,953¹.

Jaeger et al. shows a plastic nut (26) having an insertion hole (28) serving to hold a screw (20), a flange (30) having a through hole (28) positioned on one side of the component (12), and a separate sealing washer (18) integrally provided on a side of the flange (30) facing the component (60), snap action hooks (40) to bear on an opposite side of the component (12), the sealing washer (18) surrounds the flange (30), has a shoulder (outside edge of 18) embracing an outer edge of the flange (30), and a collar² projecting into the through hole (28).

However, Jaeger et al. does not show the separate and integrally formed sealing washer to be "completely" surrounding the flange (30).

At the time of invention, it would have been obvious to modify the sealing washer suggested by Jaeger et al. to "completely" surround the flange as a matter of preference in the amount of washer sealant material used. It would be readily understood and appreciated by those of ordinary skill in the art, that the sealing washer (18) could be made with enough material to completely surround the flange if so desired, in order to provide an "extra" moisture sealing capacity, beneficial damping characteristics, resistance to vibration, increased friction, and to create more spring force between the panels (e.g., 'components').

As for claim 5, it is clearly shown in Figure 9, that the integrally provided sealing washer (18) merges from a side facing away from the flange (30) into a ring that projects into the aperture of the component (12).

¹ See conclusion of previous office action dated 06 December 2004, which cited this pertinent reference.

² Shown in Figure 9, described in col. 5 lines 33-38, claims 3 and 7.

As for claim 7, the collar projects beyond the flange (30). In fact, it is essential the collar project beyond the flange if the flange is "completely surrounded" by the sealing washer.

As for claim 9, Jaeger et al. show a compressible spacer (upper 38) that connects the flange (30) to the nut (26).

As for claim 11, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Response to Arguments/Remarks

Claim Rejections - 35 USC § 103

[7] Claims 1-6, and 9-10 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. US-6,443,678 in view of Benoit US-5,301,396.

Claims 1, 4, 6, 9, and 11 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. US-6,443,678 in view of Cordola et al. US-5,173, 026.

Claims 1, 4, 6, 7 and 9-11 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. US-6,443,678 in view of Sturies et al. US-6,315,510.

Claim 5 was previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. US-6,443,678 in view of Mills et al. US-2,872,961.

Claims 4, 5, and 7 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. US-6,443,678 in view of Benoit US-5,301,396 and in even further view of Wollar US-4,832,551.

Claims 6, 8, and 11 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. US-6,443,678 in view of Benoit US-5,301,396 and in even further view of Ueno US-5,846,040.

Applicant's arguments/remarks with regard to these rejections have been fully considered, and are persuasive. Mizuno et al. teach away from a "separate" sealing washer, by forming a previously separate washer into the plastic nut body as one piece.

Allowable Subject Matter

[8] Claims 2, 3, 4, 8, and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

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[9] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows:

US 5,314,280 Figures 1 and 2 show an integrally provided sealing washer (20,27) that surrounds most of the flange (26) of a similar plastic nut having snap action hooks (28) and a through hole (21) adapted to receive a screw (16,17,19).

US-5,725,343 to Smith shows a flange (2b) of a similar panel nut completely covered by a "separate" sealing washer (7).

[10] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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[11] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Sharp whose telephone number is (571) 272-7074. The examiner can normally be reached 7:00 am - 5:30 pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAS


ROBERT J. SANDY
PRIMARY EXAMINER


5/3/05